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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/441,074 | 11/16/1999 | SEISHI SUEHIRA | 1075.1122/JD | 3826 |

21171 7590 12/23/2003

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| EXAMINER |
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PANNALA, SATHYANARAYA R

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| ART UNIT | PAPER NUMBER |
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2177

DATE MAILED: 12/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,074

Applicant(s)

SUEHIRA, SEISHI

Examiner

Sathyanarayan Pannala

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 9, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al. (US Patent 6,014,680).
3. Sato anticipated independent claim 9 by the following:
 - "The structured document being recorded..." at Fig. 38, col. 15, lines 9-10;
 - "The data file at least having a region..." at Fig. 38, col. 15, lines 18-27;
 - "A plurality of element declarations..." at Fig. 38, col. 15, lines 3-41;
 - "For each of the plurality of entity declarations..." at Fig. 1 & 7, col. 9, lines 19-24.

4. As per dependent claim 10, Sato anticipated "the plurality of different logical structures include a logical structure form layout and a table form layout" at

Fig. 1, 4, 19 & 38, col. 11, lines 44-55 and col. 15, lines 3-41.

5. Sato anticipated dependent claims 11-12, "A computer-readable recording ..." at

Fig. 19, col. 6, line 67 to col. 7, line 35 and col.23, lines 60-62.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (US Patent 6014680) and in view of Wanderski et al. (US Patent 6,519,617).

8. As per independent claims 1, 7, 13-14, Sato rendered by the following:

"Preparing at least one document instance..." at Fig. 1-4, col. 8, lines 10-15 and lines 24-64;

"Validating one of said entity declarations..." at Fig. 1, 7-9, col. 9, lines 19-65;

"Creating said structured document ..." at Fig. 5, 16 & 17, col. 8, lines 24-64 and col. 14, lines 1-46.

The other limitations of claim 14 are:

"A memory storing the structured document" at Fig. 18, col. 7, lines 15-22;

Sato does not teach specifically creating a structured document using XML.

However, Wanderski teaches the following limitation:

"A display displaying the structured document, wherein the structured document is an XML document" at Fig. 3, col. 9, lines 43-63 and col. 14, lines 43-47.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to incorporate XML as an alternate language to create structured document. Sato and Wanderski are combined as they teach creating structured documents using Data Type Definition and to relate XML in addition to SGML. In addition to creating structured document using Data Type Definition in standard generalized markup language (SGML) an alternate structured language extended markup language (XML) is used.

9. As per dependent claim 2, Sato teaches "A structured document creation ..." at Fig. 1 & 7, col. 9, lines 19-24.
10. As per dependent claims 3, 4, Sato teaches "logical structure form layout and table form layout" at Fig. 1, 4, 19 & 38, col. 11, lines 44-55 and col. 15, lines 3-41.
11. As per dependent claims 5-8, Sato teaches "structured document is a SGML document" at Fig. 1, col. 8, lines 10-15.

Response to Arguments

12. Applicant's arguments filed 9/9/2003 have been fully considered but they are not persuasive.

First, applicant states that amended claims 1, 9, 13 and 14 of the present invention recites "a plurality of element declarations which respectively define a plurality of types of logical structures for said one document instance".

In **response** to the applicant's argument, the same prior art by Sato teaches claims as an example see at Fig. 1-4, col. 8, lines 10-15, lines 24-64 and Fig. 38, col. 15, lines 3-41. The second prior art of Wanderski et al., teaches the claim 14 limitations using specifically XML structured document language, see at Fig. 3, col. 9, lines 43-63 and col. 14, lines 43-47. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

15. If a reference indicated, as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (703) 305-3390. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 746-7239.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Sathyanarayan Pannala
Examiner
Art Unit 2177

srp
December 12, 2003


GRETA ROBINSON
PRIMARY EXAMINER